

### **REMARKS**

Applicants request reconsideration and a Notice of Allowance for all claims.

#### **Amendments to Abstract and Claims**

Applicants amended the Abstract to obviate the pending objection (Office Action, page 2, paragraph no. 1, third paragraph therein.

Applicants present claims 1-22 for examination. The amended claim finds basis in the original specification throughout and the amendment is believed to avoid new matter. The amendment is presented to overcome formality objections and the like in an effort to advance prosecution.

#### **Renewed Traversal of the Restriction Requirement**

Applicants respectfully request reconsideration and withdrawal of the restriction requirement. See, 37 CFR 1.475 ("Unity of Invention before the International Searching Authority, the International Preliminary Examination Authority and during the national stage.") In the present application, it is clear the International Authority necessarily applied the PCT rules and it is beyond cavil that the International Authority concluded ***all*** claims could and should be examined together – there was unity of invention – as seen from the Written Opinion of the International Searching Authority. This information is already of record in this Application.

Diverging from the PTO rules concerning national stage applications seems inapposite and therefore Applicants courteously request the Examiner to rescind (withdraw) the requirement for restriction.

#### **Traversing the non-statutory common law rejection**

Applicants traverse the common law rejection – not a statutory rejection – of their present claims 1-3, 6-9, 11 and 12 over claims 1-4 and 8-13 of U.S. Patent 7,018,651. The

Examiner has applied the claims in the '651 patent with another secondary reference as if making a statutory rejection under 35 U.S.C. 103(a).

Applicants respectfully submit the rejection should be reconsidered and withdrawn. The common law rejection is by definition different from the statute, and analysis according to the latter has no bearing on the former. Recently the Board of Appeals had this to say about the differences:

The analyses for obviousness under 35 U.S.C. §103 and obviousness type double patenting are not identical; for one thing, "[t]he objects of comparison are very different: Obviousness compares claimed subject matter to the prior art; nonstatutory double patenting compares claims in an earlier patent to claims in a later patent or application." *Geneva Pharms., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1378 n.1 [68 USPQ2d 1865] (Fed. Cir. 2003). The purpose of an obviousness-type double patenting rejection is "to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later." *In re Berg*, 140 F.3d 1428, 1431 [46 USPQ2d 1226] (Fed. Cir. 1998).

See, *Ex parte Whelan*, 89 U.S.P.Q.2d 1078, 1081 (BOPAI 2008).

Applicants respectfully note the Board's approach echoes the Federal Circuit's instruction from 1992:

Our precedent makes clear that the *disclosure* of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the *disclosure is found in the claims*. See, e.g., *Braat*, 937 F.2d at 594 n.5, 19 USPQ at 1293 n.5 ("The patent disclosure must not be used as prior art"); *Vogel*, 422 F.2d at 442, [164 USPQ at 622] (in considering obviousness-type double patenting, "the patent disclosure may not be used as prior art"); *In re Plank*, 399 F.2d 241, 242, [158 USPQ 328, 329] (CCPA 1968) ("Its claims [Plank et al. patent] are used as the basis for a double patenting rejection. It is not a prior art reference"); *In re Aldrich*, 398 F.2d 855, 859, [158 USPQ 311, 314] (CCPA 1968) ("double patenting rejections cannot be based on section 103, . . . or on the disclosures of the patents whose claims are relied on to demonstrate double patenting or on the 'disclosures' of their claims. . . . [P]atent claims are looked to only to see what *has been patented*, the subject matter which *has been protected*, not for something one may find to be

disclosed by reading them"); *In re Boylan*, 392 F.2d 1017, 1018 n.1, [157 USPQ 370, 371 n.1] (CCPA 1968) ("in analyzing cases of these types, it must always be carefully observed that the appellant's patent is not 'prior art' under either section 102 or section 103 of the 1952 Patent Act"); *In re Braithwaite*, 379 F.2d 594, 600 n.4, [ 154 USPQ 29, 34 n.4 ] (CCPA 1967) ("While analogous to the non-obviousness requirement of 35 U.S.C. Section 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not prior art"); *Borah*, 354 F.2d at 1018, [148 USPQ at 221] ("We have no prior art here"); *In re Sutherland*, 347 F.2d 1009, 1015, [146 USPQ 485, 491] (CCPA 1965) ("Nor is obviousness invariably involved in 'double patenting' rejections. Claims relied on in such [double patenting] rejections often disclose or name the very *thing* being claimed [in the rejected claims]. Furthermore, the words of such claims cannot be treated as 'prior art,' . . . but are looked to solely for the purpose of determining *what has already been patented*. They are not treated as prior art for the simple reason they are no more 'prior art' under the statute than the specification") (citation omitted); *In re Sarett*, 327 F.2d 1005, 1013, [140 USPQ 474, 481] (CCPA 1964) ("We are not here concerned with what one skilled in the art would be aware [of] from *reading* the claims but with *what inventions the claims define*.")

See, *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1946 (Fed. Cir. 1992).

Applicants respectfully point out the claims in the cited '651 patent do not claim the same invention as defined by Applicants present claims, nor would the cited '651 patent claims as a whole have suggested the patentably distinct inventions defined by Applicants' present claims. Citing an applying a secondary reference as if this were a statutory rejection seems inapposite in view of *General Foods*, *supra* and *Ex Parte Whelan*, *supra*.

Accordingly Applicants respectfully solicit reconsideration and withdrawal of the common law rejection against their claims 1-3, 6-9, 11 and 12.

#### **Claims 4, 5, 16 and 21 are definite.**

Claim 4 is consistent with claim 1 and Applicants request the Examiner to reconsider and withdraw the formality rejection of claim 4 and claim 5.

Applicants do not see the basis for a rejection of claims 16 and 21 and suggest the rejection be favorably reconsidered and withdrawn. It is improper to ignore the product-by-process language recited in claim 16.

**Claims 1-13 and 16-21 define unobvious inventions.**

Applicants respectfully request favorable reconsideration and withdrawal of the obviousness rejection (35 U.S.C. 103(a)) over Burger in view of Menzi.

The Office Action cannot support an obviousness rejection by simply finding various elements in separate references. As the Supreme Court recently stated, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1717, 1741 (2006). *KSR* further states:

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

*Id.* Thus, it is clear that simply showing that each element of a claim is in the prior art, as the present Office Action has done, is not enough to support an obviousness rejection, especially where, as here, the primary reference is admittedly “silent as to the particles being further coated with a modified cellulose having reversible gel formation properties upon temperature increase and the weight ratio of this coating (claims 1 and 13).” Office Action, page 5, paragraph 19. Piecing together prior art to reassemble the claimed invention seems inapposite even in view of the *KSR* decision.

**Claim 14 defines an unobvious invention.**

Applicants traverse the rejection of claim 4 and respectfully request reconsideration and withdrawal of the obviousness rejection (35 U.S.C. 103(a)) over Burger, Menzi and Yolles. Again, Applicants courteously submit that simply finding elements in the prior art and piecing

them together is not sufficient. The primary reference (Burger) is admittedly "silent as to the particles being further coated with a modified cellulose having reversible gel formation properties upon temperature increase and the weight ratio of this coating (claims 1 and 13)." Office Action, page 5, paragraph 19. The primary and secondary reference are admittedly "silent as to the type of modified cellulose to be used in the coating." Office Action, page 7. Therefore simply finding a species of cellulose and citing to Yolles does not seem sufficient to raise a *prima facie* case, and thus Applicants respectfully solicit favorable reconsideration and withdrawal of this rejection.

**Conclusion:**

Applicants have endeavored to respond fully to all matters and courteously solicit favorable reconsideration followed by a Notice of Allowance.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any required fees not otherwise authorized, including application processing, extension, and extra claims fees, to Deposit Account No. 06-1135 regarding our order number 8907/84445.

Respectfully submitted,

**FITCH, EVEN, TABIN & FLANNERY**

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